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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/409,457	09/30/1999	MARTIN C. FLAUTT	24649A	5361

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EXAMINER

EGWIM, KELECHI CHIDI

ART UNIT	PAPER NUMBER
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1713

DATE MAILED: 08/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/409,457

Applicant(s)

FLAUTT ET AL.

Examiner

Dr. Kelechi C. Egwim

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 July 2005.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 50 and 52-69 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 50 and 52-69 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
• Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 50 and 52-69 are still rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

3. In claim 50, from which the balance of the claims depend, it is unclear whether the film forming binder solution is part of the final article as a component or whether it is simply to be used, along with the superabsorbent polymer precursor solution, to form the coating on said surface of the article. See MPEP § 2172.01.

Also, in claim 50, applicant is claiming the superabsorbent polymer precursor solution as being part of "said coating" which is formed on "at least one surface" of an article. However, applicant, in the same claim, recites that once the coating is formed (cured) on "at least one surface" of an article, that the superabsorbent polymer is no longer in the form of the superabsorbent polymer precursor solution, but is in the form of the "superabsorbent polyacrylate polymer". Is the "superabsorbent polymer precursor solution" part of the final article coating, as a component of the coating, or simply used to form the coating on said surface of the article, in which case the coating would contain the actual superabsorbent polyacrylate polymer, not the precursor?

4. Due to amendments and persuasive arguments by applicant, the previous rejections of record based on Shiono et al., Kroesbergen or Manning et al. have been overcome and are hereby withdrawn.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 50 and 52-69 are rejected under 35 U.S.C. 102(b) as being anticipated by or, in the alternative, 35 U.S.C. 103(a) as being unpatentable over Kono et al., Gaa et al. or Cossement et al.

7. Claims 50 and 52-69 are rejected under 35 U.S.C. 103(a) as being unpatentable over Arroyo et al. or Geursen et al. in combination with Barch et al., for reasons cited in previous actions.

Response to Arguments

8. Applicant argues that Kono et al., Gaa et al. or Cossement et al., "do not disclose ... a water-soluble superabsorbent polymer precursor in aqueous solution that cures when the coating is applied to the surface to form a superabsorbent polyacrylate

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polymer.". However, Kono et al., Gaa et al. or Cossement et al., do teach the superabsorbent polyacrylate polymer. The fact that the prior art may not explicitly teach the method of forming the polyacrylate polymer from a polymer precursor in aqueous solution, does not negative the teach of the claimed product itself.

The product is the same as, or an obvious variant of, the presently claimed product absent evidence that the particular process of making results in a materially different product. Even though product-by-process claims are limited and defined by the process, determination of patentability is based on the product itself. The patentability of the product does not depend on it's method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. See *In re Marosi*, 218 USPQ 289 (Fed. Cir. 1983) and *In re Thorpe*, 227 USPQ 964 (Fed. Cir. 1985). See also MPEP § 2113.

9. Applicant also argues that Kono et al. or Gaa et al. "do not teach said polymer absorbs water when it is wetted and desorbs water when it is dried", however, as stated in prior actions, while the cited art may not expressly teach the disclosed properties of the claimed coating, it is still reasonable that the prior art coatings would poses the presently claimed properties since the compositions are essentially the same as the claimed composition and the USPTO does not have at its disposal the tools or facilities deemed necessary to make physical determinations of the sort. In any event, an otherwise old composition or article is not patentable regardless of any new or

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unexpected properties. In re Fitzgerald et al , 619 F.2d 67, 205 USPQ 594 (CCPA 1980). See MPEP § 2112 - § 2112.02.

Even if assuming that the prior art references do not meet the requirements of 35 U.S.C. 102, it would still have been obvious to one of ordinary skill in the art, at the time the invention was made, to arrive at the same inventive composition because the disclosure of the inventive subject matter appears within the generic disclosure of the prior art.

10. Further, regarding the argument that "Cossement et al. do not specifically teach ... a viscosity-modifying agent, a lubricant or a film forming binder", as can be seen in col. 3 of Cossement et al., the polyacrylate polymers of Cossement et al. modify the viscosity of the solution and thus qualify as "viscosity modifiers". Also, the polyurethane polymers of Cossement et al. are consistent with the claimed binders and the lubricant, as an additive, is taught in col. 5, lines 50-58 of Cossement et al.

11. Regarding the rejection of claims 50 and 52-69 under 35 U.S.C. 103(a) as being unpatentable over Arroyo et al. or Geursen et al. in combination with Barch et al., as stated above, the claims are to the product, not to the process of preparing the product. Patentability cannot solely be based on whether or not the prior art teach the method for forming the claimed product.

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12. Regarding the argument the Geursen et al. do not teach “any of the additional components of the coating recited in claim 50 including a viscosity modifying agent, a lubricant and film forming binder”, applicant is directed to col. 4, lines 31-35, where Geursen et al. teach lubricants and diluents as additive in the composition.

13. As already stated in previous actions in response to applicant's argument that there is no suggestion to combine the compositions of Arroyo et al. or Geursen et al. with binder of Barch et al, each of Arroyo et al. (col. 3, line 1-15 and col. 4, lines 11-20) and Geursen et al. (col. 1, lines 7-10 and col. 3, lines 31-41) teach superabsorbent-coatings for fibrous substrate comprising a water-soluble polymer and other components such as lubricants and viscosity modifying polymers, and Barch et al. (See col. 6, lines 18-20) teach the incorporation of binders into coating compositions for fibrous **substrate for the purpose of facilitating the formation of a film on the substrate** upon the drying of the coating composition. There in lies the motivation.

14. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

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extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dr. Kelechi C. Egwim whose telephone number is (571) 272-1099. The examiner can normally be reached on M-T (7:30-6:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on (571) 272-1114. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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KELECHI C. EGWIM PH.D.
PRIMARY EXAMINER